

REMARKS

Favorable reconsideration of this application in light of the following discussions is respectfully requested.

Claims 1-10 remain pending in the present application.

In the outstanding Office Action, Claims 1, 3, and 4 were provisionally rejected on the grounds of non-statutory obviousness-type double patenting over Claim 1 of co-pending U.S. Patent Application Serial No. 10/519,833; and Claims 1-10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Masaharu (JP 2003-029795 A) and in view of the background art.

Regarding the provisional rejection of Claims 1, 3, and 4 on the grounds of non-statutory double patenting over Claim 1 of co-pending application number 10/519,833, Applicant respectfully requests that this rejection be held in abeyance until the present application is in condition for allowance for the following reasons. A terminal disclaimer can be filed, if the claims in the present application remain obvious in view of the claims of the cited U.S. patent application (10/519,833) at the time of allowance of the present application. Furthermore, additional amendments (if needed for allowance of these claims) may eliminate the double-patenting rejection, making the filing of a Terminal Disclaimer at this time premature. Indeed, M.P.E.P. § 804.02 IV states that, prior to issuance, it is necessary to disclaim each one of the double patenting references applied. Hence, Applicant respectfully requests that the examiner contact the undersigned should the present amendments and arguments be accepted and should the present application be otherwise in condition for allowance. At that time, a terminal disclaimer, if warranted, can be supplied to expedite issuance of this case.

Regarding the rejection of Claims 1-10 under 35 U.S.C. §103(a) as unpatentable over Masaharu (JP 2003-029795) and in view of Figs. 1-3 of background art, Applicant respectfully traverses the rejection.

The Office Action concedes on page 8 that Masaharu does not disclose or suggest “a second set that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to entities of audio data contained in each of the first sets,” and relies on the background art to cure this deficiency.

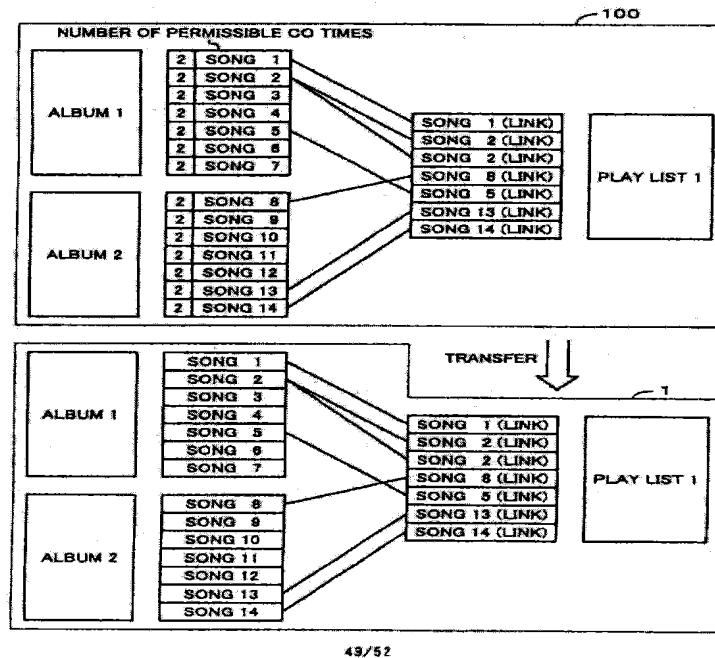
By way of review, Claim 1 recites a data transferring system for transferring audio data between a first recording medium and a second recording medium, including

a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes **pointers to tracks of audio data contained in each of the first sets**; and

controlling means for **transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium** when audio data described in the second set are transferred to the second recording medium.

In an exemplary embodiment of the claimed invention, Applicant’s Figure 52 (reproduced below for the Office’s convenience) shows an example of Applicant’s data transferring system for transferring audio data between a first recording medium and a second recording medium. As can be seen from Fig. 52, the data structures of Albums 1 and 2 and Play List 1 are all preserved after transfer. Therefore, after transfer, all of Songs 1-7 remain associated with Album 1, all of Songs 8-14 remain associated with Album 2, and Play List 1 includes links to Songs 1, 2, 2, 8, 5, 13, and 14. The links between Play List 1 and Albums 1 and 2 are also maintained, i.e., Song 1 (link), Song 2 (link), … , and Song 14 (link), as described in Play List 1, still point to the songs referenced from Album 1 and Album 2, just as they did before transfer.

**Fig. 52**

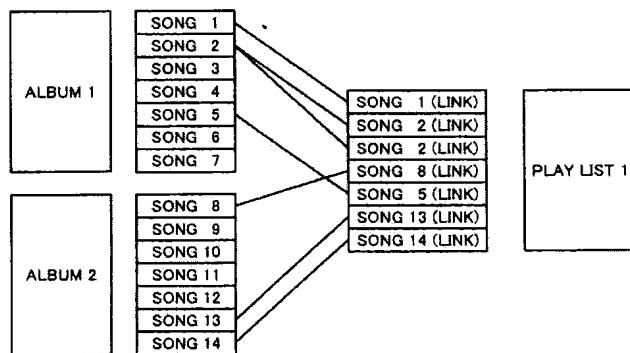


The Response to Arguments section of the Office Action merely draws the conclusion that Masaharu and the background art “teach the same thing that is being claimed.” However, the Response to Arguments section provides no response to Applicant’s previously filed arguments.

Further, on page 8 of the Office Action, the Office asserts that “applicant uses Figs. 1-3 to show reproduction order and pointers to entities of audio data.” However, Applicant respectfully submits that “reproduction order and pointers to entities” is not claimed. Applicant claims “a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets.”

Turning to the background art, Figs. 1-3 are described in the background art section as systems used by conventional recording and reproducing apparatuses. Fig. 1 (reproduced below for the Office’s convenience) illustrates the basic concept of a play list and an album.

**Fig. 1**



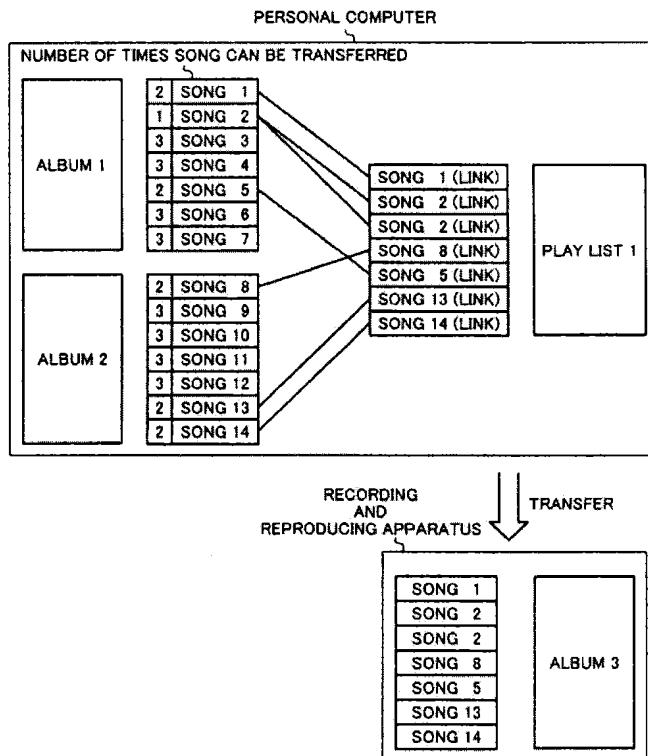
Thus, as seen in Fig. 1, Play List 1 describes only *pointers to songs*, and not songs themselves. Accordingly, even if Song 1 (link), Song 2 (link), etc. are deleted from Play List 1, only the links are removed, not the corresponding songs, such as Song 1 and Song 2.

Hence, Fig. 1 of the background art does not teach a play list that... describes *pointers to tracks of audio data* contained in each of the albums. Accordingly, all tracks of audio data contained in the albums that contain audio data described in the play list cannot be transferred from a first recording medium to a second recording medium.

Thus, Fig. 1 of the background art does not disclose or suggest "a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets," and "controlling means for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium," as recited in Claim 1.

Figs. 2 and 3 of the background art illustrate a conventional way for transferring songs corresponding to Play List 1 to a recording and reproducing apparatus. As seen in Fig. 2 (reproduced below for the Office's convenience), Play List 1 contains *links* to songs from both Album 1 and Album 2.

**Fig. 2**

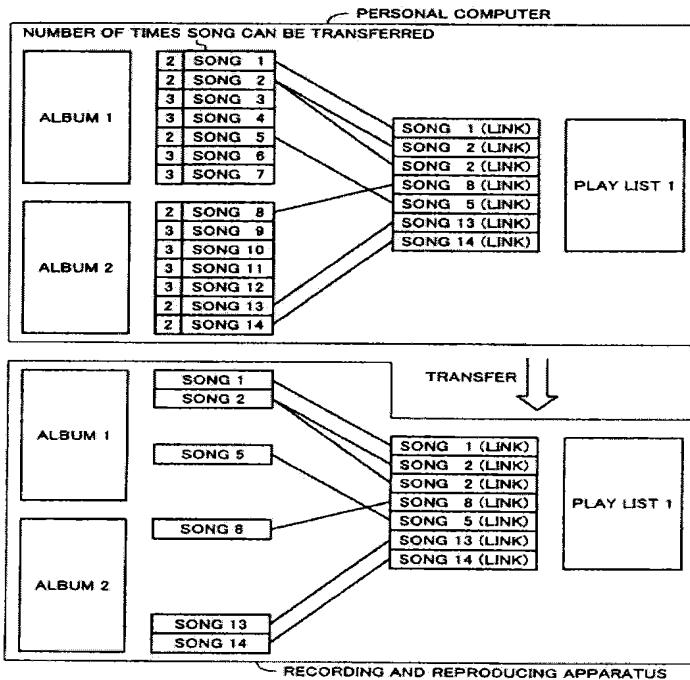


However, during transfer from the personal computer to the recording and reproducing apparatus, the concept of the play list is lost and the songs are recorded as a structural concept of an album, i.e., as the songs themselves. That is, Album 3 is created in the recording and reproducing apparatus in place of Play List 1, and *the links to songs are not maintained*. Accordingly, the data associated with which songs correspond to Album 1 and which songs correspond with Album 2 is lost.

Hence, Fig. 2 of the background art does not teach a play list that... describes *pointers to tracks of audio data* contained in each of the albums. Accordingly, all tracks of audio data contained in the albums that contain audio data described in the play list cannot be transferred from a first recording medium to a second recording medium.

In Fig. 3 (reproduced below for the Office's convenience), the concept of a play list is kept after transfer to the recording and reproducing apparatus.

**Fig. 3**



However, Fig. 3 differs from the structure of Fig. 2 in that, while the links between the songs in the play list and the albums are kept (Song 1 has a pointer to Song 1 of Album 1, Song 14 has a pointer to Song 14 of Album 2, etc.), the songs not on Play List 1 are no longer associated with Albums 1 and 2. As can be seen, Songs 3-4 and 6-7 of Album 1 are missing from Album 1 after transfer, and Songs 9-12 are not missing from Album 2 after transfer. Accordingly, data structure, and consequently, integrity, is lost in the structures of Figs. 2 and 3.

Hence, Fig. 3 of the background art does not teach a play list that... describes **pointers to tracks of audio data** contained in each of the albums. Accordingly, all tracks of audio data contained in the albums that contain audio data described in the play list cannot be transferred from a first recording medium to a second recording medium.

Thus, Figs. 2 and 3 also do not disclose or suggest "a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data

contained in each of the first sets,” and “controlling means for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium,” as recited in Claim 1.

M.P.E.P. § 2143.03 requires, to establish a case of *prima facie* obviousness, that all words in a claim must be considered in judging the patentability of the claim against the prior art. Further, M.P.E.P. § 2123 I states that a reference may be relied on for all it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

Accordingly, with the background art being silent regarding both a play list that describes pointers to tracks of audio data contained in each of the albums, and all tracks of audio data contained in the albums that contain audio data described in the play list being transferred from a first recording medium to a second recording medium, Applicant respectfully submits that Masaharu and the background art do not disclose or suggest, either separately or combined, “a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets,” and “controlling means for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium,” as recited in Claim 1.

Therefore, Masaharu and the background art do not disclose or suggest, either separately or combined, “a data transferring system,” as defined in independent Claim 1. Accordingly, independent Claim 1 (and Claims 2-4 dependent therefrom) patentably defines over Masaharu and the background art.

Moreover, *assuming arguendo* that the background art provided the claimed “a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets,” the examiner’s choosing to extract from only those elements from the background art needed to deprecate the invention in the asserted combination of Masaharu and the background art would be evidence of improper hindsight reconstruction being used in the Office Action. The court in In re Mercier, 185 USPQ 774 (CCPA 1975) stated that

The board's approach amounts, in substance, to nothing more than a hindsight “reconstruction” of the claimed invention by relying on isolated teachings of the prior art without considering the over-all context within which those teachings are presented. *Without the benefit of appellant's disclosure*, a person having ordinary skill in the art would not know what portions of the disclosure of the reference to consider and what portions to disregard as irrelevant, or misleading. See In re Wesslau, 53 CCPA 746, 353 F.2d 238, 147 USPQ 391 (1965). [Emphasis added]

Indeed, without Applicant’s disclosure, one would have no basis to even assume that the digital player provided by Masaharu is in any way deficient or in need of improvement. Further, there is nothing in Masaharu to suggest that a play list that describes pointers to tracks of audio data contained in each of the albums would in any way have a beneficial effect on the transferring of the contents of the data from the favorite list file (pieces of music) from a PC to the digital memory player tracks in Masaharu, particularly as Masaharu is directed to data volume considerations.

Therefore, for all of the above reasons, it is respectfully requested that the rejection of Claims 1-10 under 35 U.S.C. §103(a) as unpatentable over Masaharu and in view of Figs. 1-3 of background art be withdrawn.

Independent Claims 5 and 8, while differing in scope and statutory class from Claim 1, patentably define over Masaharu in view of the background art for substantially the same

reasons as Claim 1. Accordingly, it is respectfully submitted that Masaharu and the background art do not anticipate or make obvious the features of independent Claims 5 and 8. Therefore, independent Claims 5 and 8 (and the claims dependent therefrom) are believed to patentably define over Masaharu in view of the background art.

Consequently, in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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